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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,585	03/30/2004	Bertram Rupietta	RUPIETTA ET AL. - 1	4312
25889	7590	04/05/2006		
			EXAMINER	
			DANIELS, MATTHEW J	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/813,585	RUPIETTA ET AL.
	Examiner	Art Unit
	Matthew J. Daniels	1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 January 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
  - 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/13/06, 2/27/06.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. In the reply filed 13 January 2006, Claim 15 was amended. There are no new claims.

***Election/Restrictions***

2. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Information Disclosure Statement***

3. The information disclosure statements filed 13 January 2006 and 27 February 2006 fail to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. **Claim 14** is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 10/813,605 in view of Haddy (USPN 4690631). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

The language of Claim 14 of the instant application and Claim 15 of the '605 application appears to be the same except for the presence of a turntable in the '605 application. However, turntables are known and obvious in the art of forming concrete pipes, and this aspect is taught by Haddy (Fig. 1, Item 16). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Haddy into the instant application in order to provide a simple and efficient means for moving pipe between stations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

5. The rejection of Claim 15 set forth previously is withdrawn in view of the amended claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 14 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ottmann (USPN 4041118). As to **Claim 14**, the “means” language of the claim is not interpreted as having invoked 35 USC 112, sixth paragraph, because part (A) of the three-prong analysis set forth in MPEP 2181 (I) is not met. Ottmann teaches a method for the production of a multi-layer concrete pipe, comprising the following steps:

moving a mold mantle, which stands essentially vertically, into a stand (Fig. 1, Items 10 and 12, the mold is moved with a hoist, Fig. 4, Item 50);

filling the mold mantle with first concrete mixture by means of a first charging system (Fig. 1, Item 22);

distributing and compacting the concrete mixture in the mold mantle by means of a rotating and vertically displaceable compacting tool (Fig. 1, Items 20, 18, 16, 24);

moving the mold mantle, which stands essentially vertically, out of the stand and removing the concrete pipe from the mold (Ottmann’s method uses a hoist, *supra*);

wherein before the concrete pipe is removed from the mold, a second concrete mixture filled into the mold mantle, said mold mantle standing essentially vertically, and a diameter of the compacting tool for distributing and compacting the second concrete mixture is reversibly reduced (3:22-45). Ottmann is silent to pivoting the mold into or out of the stand. However, this

limitation does not materially affect the claimed method of making the concrete pipe because it is only a positioning step which does not affect the concrete pipe. However, Ottmann's teaching of a hoist would render obvious the aspect of pivoting because pivoting of the mold may be performed in order to align the mold and second tool to ensure that the second tool does not damage the first layer, or because hoisting cranes often pivot, and it would have been obvious to pivot Ottmann's hoist during positioning. **As to Claim 15**, It is the Examiner's position that this claim does not materially affect the claimed method for producing a multi-layer pipe because it occurs after the concrete pipe is removed from the compacting tool and from the mold (mantle). Although Ottmann appears to be silent to the claimed limitation, it would have been *prima facie* obvious in view of Ottmann's teaching that the apparatus may be expanded or contracted selectively (2:36-46). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to expand the compacting tool after removal of the concrete pipe to clean the tool and the vertical tool seam prior to the next molding cycle, or to engage the next pipe to be compacted.

7. **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ottmann (USPN 4041118) in view of Gowing (USPN 2533579). Ottmann teaches the subject matter of Claim 14 above under 35 USC 103(a). **As to Claim 16**, Ottmann appears to be silent to the claimed aspects of after distributing the first concrete mixture and compacting it, changing a direction of rotation. However, this aspect is known in the art and is taught by Gowing (6:18-23). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Gowing into that of Ottmann in order to provide an extremely smooth

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(6:21) and hard inner surface (6:37-38) lacking large cavities (6:44), and being generally impervious (6:46).

8. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ottmann (USPN 4041118) in view of Fosse (USPN 4340553). Ottmann teaches the subject matter of Claim 14 above under 35 USC 103(a). **As to Claim 17**, Ottmann is silent to the claimed limitation. However, Fosse teaches that rotation speed is a result-effective variable (1:45-52), depending on whether metering or finishing is being performed (1:36-41). In view of Fosse's teachings, it would have been *prima facie* obvious to optimize and change rotation speed depending on the desired effect of the compacting process (metering or finishing). See MPEP 2144.05 II and *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

#### *Response to Arguments*

9. Applicant's arguments filed 11 January 2006 have been fully considered but they are not persuasive. The arguments appear to be on the following grounds:

- a) Claim 14 of the present application differs from Claim 15 of the parallel application because in the present case two different layers of the pipe are formed by one compacting tool, and in the parallel case, the same compacting tool is used to form both layers.
- b) Applicant has amended claim 15 to clarify the invention and to reversibly enlarge the diameter so that it can be used for the first layer of a new pipe.
- c) Ottmann teaches a single layer concrete pipe, and does not form a multilayer.

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d) The contracted condition of the vibrating cylinder of Ottmann is only used for lowering the pipe and the jacket. However, a reduction of the outer diameter of the cylinder is not desired during the compacting of Ottmann.

10. These arguments are not persuasive for the following reasons:

a) The Applicant's arguments indicate that the applications are distinct because of the use of a single tool used twice, or two tools each being used once. However, these limitations are drawn only to the apparatuses used, and do not distinguish the stepwise process limitations of the two claimed *methods*. The Examiner submits that this difference, by itself, is not sufficient to distinguish the two applications from being obvious over one another. It is additionally noted that the claims cited in the rejection only distinguish the number of tools, but do not distinguish the tools by their functions.

b) The Examiner submits that the clarified Claim 15 is still drawn to a positioning step, which does not, by itself, materially affect the claimed method. However, the Examiner submits that when Ottmann reduces the diameter of the tool to facilitate removal, it would have been *prima facie* obvious to reversibly enlarge the diameter of the compacting tool of Ottmann in order to engage the next pipe.

c) The Applicant's claim does not require that the first and second mixtures are different, and therefore first and second applications of Ottmann's mix render the claimed subject to the mixes *prima facie* obvious. Additionally, the Applicant's arguments appear to assert that a first and second application of Ottmann's mix produce a single layer (page 9, bottom). However, the Applicant's remarks do not appear to consider Ottmann's teaching at 3:3-32, and in particular,

Ottmann's teaching of the effect of the vibrating (3:5). This vibrating, which is performed *between the first and second applications of mix*, compacts the first layer, eliminates voids, and relieves residual stresses in that layer. While the Applicant's remarks appear to assume that no strata, or multilayers, are present in the pipe of Ottmann, the Examiner's position is that *because Ottmann clearly teaches that there is a structural change in the first layer applied due to the vibration treatment of the pipe, and because Ottmann further teaches that the second layer of mix does not undergo such vibration, that there would obviously be stratification in Ottmann's pipe*. Additionally, Ottmann's movement back and forth to the vibration station clearly was not instantaneous. Because some degree of curing would obviously have occurred during the movement and vibration, the Examiner submits that the second layer would have obviously behaved differently during the application process than the first layer, further distinguishing and stratifying the two layers applied in Ottmann's process.

Additionally, Ottmann clearly teaches that the second mix is applied to produce an excellent finish (3:44) and fill voids. The Examiner submits that the ordinary artisan would have found suggestion, and it would have been *prima facie* obvious, to vary the characteristics of the mix, such as aggregate size, to achieve these objectives. No particular details about any compositional differences between the layers have been claimed.

**d)** In any cycle of compacting with Ottmann's compacting tool, after removal of a first part and placement of a second part, the compacting tool would necessarily be enlarged to engage the second pipe after it was placed in the tool (Claim 15). Following compaction, the diameter of the compacting tool would obviously be reduced to allow removal from the tool.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Friday, 7:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MICHAEL P. COLAIANNI  
SUPERVISORY PATENT EXAMINER

MJD 3/22/06

